

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE
THE BOARD OF PATENT APPEALS AND INTERFERENCES**

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| In re application of | Steven C. Black et al. |) | |
| | |) | |
| Serial No.: | 10/848,809 |) | |
| | |) | |
| Filed: | May 19, 2004 |) | |
| | |) | |
| Confirmation No.: | 6228 |) | Art Unit |
| | |) | 3629 |
| For: | AUTOMATED COMPLIANCE FOR HUMAN |) | |
| | RESOURCE MANAGEMENT |) | |
| | |) | |
| Examiner: | Shaun D. Sensenig |) | |
| | |) | |
| Appeal No.: | _____ |) | |

The Honorable Commissioner of Patents and Trademarks
Washington, D.C. 20231

REPLY BRIEF OF APPELLANTS

This Reply Brief of Appellants is responsive to the Examiner's Answer mailed February 2, 2010 (the "Examiner's Answer") to the Brief of Appellants filed December 7, 2009 (the "Brief of Appellants") and is hereby submitted to the Board of Patent Appeals and Interferences (the "Board") pursuant to the provisions of 37 CFR 41.41.

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LIST OF REFERENCES

U.S. PATENT DOCUMENTS

U.S. Patent No. 7,330,817 to *Exall et al.*

U.S. Patent No. 6,067,522 to *Warady et al.*

U.S. Patent Publication No. 2002/0055862 to *Jinks*

NON-PATENT LITERATURE

Peace Corps Applicant Toolkit (“*PC*”)

I. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- Issue 1: Whether claims 1-10, 29-30, and 32-34 are unpatentable, under 35 U.S.C. §101, as being drawn to patent-ineligible subject matter.
- Issue 2: Whether claims 1-11, 29-30, 32-33 are unpatentable, under 35 U.S.C. §103(a), as being obvious over U.S. Patent No. 7,330,817 to *Exall et al* (“*Exall*”) in view of Peace Corps Applicant Toolkit (“*PC*”).
- Issue 3: Whether claims 15-18 are unpatentable, under 35 U.S.C. §103(a), as being obvious over *Exall* in view of *PC*, and further in view of U.S. Patent Number 6,067,522 to Warady et al. (“*Warady*”).
- Issue 4: Whether claim 34 is unpatentable, under 35 U.S.C. §103(a), as being obvious over *Exall* in view of *PC*, and further in view of U.S. Patent Publication No. 2002/0055862 to Jinks (“*Jinks*”).

II. STATUS OF AMENDMENTS

The Examiner acknowledged that “The Appellants’ statement of the status of amendments after final rejection contained in the brief is correct.” *Examiner’s Answer*, page 2. However, the Examiner also repeated his objection and rejection of claim 35 from the Final Office Action. *Examiner’s Answer*, page 3. Appellants, therefore, want to reiterate that claim 35 was canceled in a paper filed October 6, 2009, and an acknowledgement of the paper canceling claim 35 was mailed by the Examiner on December 1, 2009. The repeated objection and rejection of claim 35 in the Examiner’s Answer is therefore moot as canceled claim 35 is not an appealed claim.

III. REPLY TO EXAMINER ARGUMENTS

Appellants note at the outset that the remarks, or a lack of remarks, herein are not intended to constitute, and should not be construed as, an acquiescence on the part of the Appellants: as to the purported teachings or prior art status of the cited references; as to the characterization of the cited references advanced by the Examiner; or as to any other assertions, allegations or characterizations made by the Examiner at any time in this case.

A. **Issue 1: Whether claims 1-10, 29-30, and 32-34 are unpatentable, under 35 U.S.C. §101, as being drawn to patent-ineligible subject matter.**

i. **The Examiner erred in asserting that the “human resources compliance form” of claim 1 does not qualify as an “article” under the *Interim Examination Instructions***

In the Examiner’s Answer, the Examiner has relied on an incorrect understanding of the current USPTO guidance on § 101 transformations. In particular, the Examiner has stated that “Based on Supreme Court precedent, and recent Federal Circuit decisions, the Office’s guidance to examiners is that a § 101 transformation must be a *‘physical transformation’*.” *Examiner’s Answer, page 14 (emphasis in original)*. However, as noted in the Brief of Appellants, the “Interim Examination Instructions For Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101” issued by the USPTO on August 24, 2009 (the “*Interim Examination Instructions*”) instruct Examiners that:

An “article”...can also be electronic data that *represents* a physical object or substance. For the test, the data should be more than an abstract value. Data can be specifically identified by indicating what the data represents, the particular type or nature of the data, and/or how or from where the data was obtained.

“Transformation” of an article means that the “article” has changed to a different state or thing...A new or different function or use can be evidence that an article has been transformed...transformation of electronic data has been found when the nature of the data has been changed such that it has a different function or is suitable for a different use.

Interim Examination Instructions, pages 5-6 (*emphasis added*). Therefore, the Examiner is simply incorrect in stating that a § 101 transformation “must be a *physical transformation*.” On the contrary, the *Interim Examination Instructions* make it clear that a § 101 transformation can be a transformation of electronic data that represents a physical object or substance. Further, as Appellants noted in a paper filed March 19, 2009:

As noted recently by the U.S. Court of Appeals for the Federal Circuit in *In Re Bilski*, 545 F.3d 943 (Fed. Cir. 2008), the “raw materials of many information-age processes ... are electronic signals and electronically-manipulated data.” *Id.* at 962. With reference to a previous court decision that upheld the patent-eligibility of a claim that transformed data representing “physical and tangible objects” into a different state, the Federal Circuit affirmed the patent-eligibility of the claim and further noted that “the electronic transformation of the data itself ... was sufficient, the claim was not required to involve any transformation of the underlying physical object that the data represented.” *Id.* at 962-63 (*citing In Re Abele*, 684 F.2d 902 (C.C.P.A. 1982)).

Page 13 (emphasis in original). Appellants have detailed in the Brief of Appellants how the electronic “human resources compliance form” of claim 1 represents a physical object, i.e. a paper “human resources compliance form.” *See pages 9-10*. Thus, to the extent that the Examiner’s position is based on a misunderstanding of the *Interim Examination Instructions* and Federal Circuit precedent, the Examiner’s position is not well taken.

In the Examiner’s Answer, the Examiner also incorrectly asserted that “Appellants argues that a physical human resource compliance [form] is *scanned* to create an electronic human resource compliance form. The simple *scanning* of a document into an electronic document/image does not represent a physical transformation.” *Examiner’s Answer, pages 14-15 (emphasis in original)*. Although Appellants noted in the Brief of Appellants that scanning is one “example of the conversion of a physical ‘human resources compliance form’ to an electronic ‘human resources compliance form’,” page 10, nowhere did Appellants argue that this scanning represents a § 101 transformation. Moreover, and as noted above, a § 101 transformation need

not be a physical transformation, but can instead be a transformation of electronic data that represents a physical object or substance. Thus, to the extent that the Examiner's position is based on a mischaracterization of Appellants' statements, the Examiner's position is not well taken.

ii. The Examiner erred in asserting that claim 1 does not recite acts that “particularly transform a particular article to a different state or thing” under the *Interim Examination Instructions*

In the Examiner's Answer, the Examiner again misstated the current USPTO guidance and Federal Circuit precedent on § 101 transformations, for at least the same reasons noted above at III.A.i. The Examiner is also mistaken in his assertion that “Appellants argues that the *updating of data* in an electronic human resource compliance form represents ‘transformation’. The simple *updating of data* of in an electronic document does not represent a physical transformation.” *Page 15 (emphasis in original)*. In fact, Appellants argued in the Brief of Appellants that the “updating” of at least one of the electronic “human resources compliance forms to conform with a change in the legal criteria” as required by claim 1 qualifies as a § 101 transformation under the *Interim Examination Instructions* because the updated form is suitable for a different use than the originally generated form. For additional explanation of this § 101 transformation, see Brief of Appellants, pages 9-11. Thus, in light of the Examiner's misunderstanding of the *Interim Examination Instructions* and Federal Circuit precedent as well as the Examiner's mischaracterization of Appellants' position, the Examiner's position is not well taken.

iii. Conclusion

For at least the foregoing reasons, Appellants respectfully submit that the Examiner has improperly rejected claim 1, and corresponding dependent claims 2-10, 29, 30, and 32-34, as

being patent-ineligible under 35 U.S.C. § 101. Accordingly, the rejections of claims 1-10, 29, 30, and 32-34 under 35 U.S.C. § 101 are not well taken and should be overruled by the Board.

B. Issue 2: Whether claims 1-11, 29-30, 32-33 are unpatentable, under 35 U.S.C. §103(a), as being obvious over U.S. Patent No. 7,330,817 to Exall et al (“Exall”) in view of Peace Corps Applicant Toolkit (“PC”).

i. Claims 1 and 11

In the Brief of Appellants, Appellants noted that the Examiner conceded in the Final Office Action that *PC* does not teach “...determining whether the change in the legal criteria requires a corresponding change in the order in which an updated human resources compliance form is presented to the client...” as recited in claims 1 and 11 (collectively the “*order change elements*”). See page 12. In the Examiner’s Answer, the Examiner again conceded that “Neither Exall [nor] PC explicitly disclose determining whether the change in the legal criteria requires a corresponding change in the order in which a form is presented to the client and presenting the forms in that order.” Page 6. Later on in the Examiner’s Answer, however, the Examiner attempts to change course by arguing that no admission was made, stating that:

Appellants argue that Examiner conceded in the final office action that PC does not teach “order change elements”. This is incorrect. Examiner retained that PC teaches “order change elements” (Final Office Action, P 6, lines 18-21) and added a rejection (in response to the amendments) in which PC does not teach “the determination of order change elements” (Final Office Action, P 6, lines 30-32). “

Page 15 (*emphasis in original*). These assertions are mistaken because, in the rejection of claim 1 in the Final Office Action, the Examiner conceded that “Neither Exall [nor] PC explicitly disclose determining whether the change in the legal criteria requires a corresponding change in the order in which a form is presented to the client and presenting the forms in that order.” *Final Office Action*, page 5. This statement in the Final Office Action is a clear concession confirming, again, the Examiner’s view that neither *Exall* nor *PC* teaches the claimed *order change elements*.

Appellants also note that the Examiner's citations to the Final Office Action fail to support his assertions. The first citation (Final Office Action, page 6, lines 18-21) is to a portion of the Final Office Action dealing with an unrelated element of dependent claim 4. The second citation (Final Office Action, page 6, lines 30-32) does not exist (lines 30-32 do not exist on page 6 as there are only 21 lines of text on page 6 of the Final Office Action). Moreover, in citing to that passage, the Examiner characterized it as stating that "PC does not teach '*the determination of order change elements*'." Examiner's Answer, page 15 (emphasis in original). Obviously, since this second passage does not exist, this second passage can not support the Examiner's characterization.

Notwithstanding the Examiner's multiple admissions that the cited references do not teach the claimed *order change elements*, however, the Examiner appears to have once again changed his position with respect to PC teaching the claimed *order change elements*. In particular, the Examiner has gone from asserting that PC does teach the claimed *order change elements*, see Office Action mailed December 19, 2008, page 4, to conceding that PC does not teach the claimed *order change elements*, see Final Office Action, page 5, to reiterating that PC does not teach the claimed *order change elements*, see Examiner's Answer, page 6, to once again asserting that PC does teach the claimed *order change elements*, Examiner's Answer, pages 15-20. Appellants note that the Examiner's flip-flopping with regard to whether PC does or does not teach the *order change elements* of claims 1 and 11 makes it difficult for Appellants to effectively respond to the Examiner's ever-changing position. Nevertheless, the Examiner's most recent position appears to be an attempt to rescind his multiple admissions and now assert that PC does teach the claimed *order change elements*.

For example, in the Examiner's Answer, the Examiner has asserted that:

Appellants claim “**determining** whether the change in the legal criteria requires a corresponding change in the order in which updated human resource compliance form is presented to the client.” PC teaches *activities being performed in a specific order based on status and legal criteria* (Pages 4-9, Steps 3 and 5-9) (some steps in the PC process have corresponding forms to be filled out as part of that step). These steps are performed in a *specific order based on status and legal criteria* such as which steps the applicant has completed and for which steps the applicant has been approved. Each step must be completed and the applicant approved for the requirements covered by said step before moving on to the next. Each step represents *requirements for eligibility* that are *determined by legal requirements for eligibility*. Any changes in legal requirements pertaining to an applicant’s eligibility for participation in the program could have an effect on the nature and/or order of these steps. The combination of the elements disclosed by Exall and Pc are obvious as applied to KSR (Combining prior art elements according to known methods to yield predictable results/next logical step)...

Pages 18-19 (emphasis in original).

Despite these assertions, however, the Examiner is mistaken in his assertion that PC teaches the claimed *order change elements*. In particular, the order in which the screens of pages 4-9 of PC are presented to a user appear to be fixed, and no evidence of this order being “changed” to accommodate a change or changes in any “legal criteria” is apparent from the face of these pages. For example, nine (9) steps are listed in a certain order on page 3 of PC, and six (6) of these nine (9) steps are shown in the same order on the screens of pages 4-9. PC makes no mention of “determining whether the change in the legal criteria requires a corresponding change in the order in which an updated human resources compliance form is presented to the client” as recited in claims 1 and 11. Rather, the Examiner has simply assumed that the claimed *order change elements* are taught by PC, thus giving rise to the appearance of having relied on official notice, even if such was not explicitly stated.

Therefore, despite the Examiner’s assertions above, and consistent with the Examiner’s admissions, the Examiner has failed to demonstrate that the claimed *order change elements* are “prior art elements.” In view of the foregoing, Appellants submit that the Examiner has failed to

establish a *prima facie* case of obviousness with regard to claims 1 and 11, at least because the Examiner has not shown that the references, even when combined in the purportedly obvious fashion, include all the elements of claims 1 and 11.

a. The Examiner has failed to demonstrate that the facts of the cited legal precedent are similar to those in the present application

In the Examiner's Answer, the Examiner asserted that "Appellants argue that Examiner has failed to demonstrate any similarity between the facts of KSR and the facts in the present application. The argued claims and related 35 U.S.C. §103 rejections are described in detail here (including an explanation of KSR rational(s))." *Pages 15-16*. It appears, therefore, that the Examiner has taken the position that the facts of the present application are similar to the facts of *KSR*. However, for at least the reasons noted in the Brief of Appellants, "the Examiner has failed to establish that the facts in *KSR* are similar to those in the present application." *Page 14*. In particular, unlike in *KSR* where the claim elements were each taught in cited prior art references, the Examiner has failed to cite any prior art reference that teaches the claimed *order change elements*. Unless and until the Examiner can demonstrate that all elements of claims 1 and 11 are disclosed or suggested in references cited by the Examiner, *KSR* is irrelevant. As discussed above, the Examiner has thus far failed to do so. The rejections of claims 1 and 11 based on *KSR* thus lack an adequate foundation and should accordingly be withdrawn.

b. The Examiner has improperly taken official notice in a final office action where the purported facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known

To the extent that the Examiner has assumed certain disclosures as made or implied in the references, Appellants maintain that the Examiner has, in effect, taken official notice as to such disclosures. In the Examiner's Answer, the Examiner has denied taking official notice with

regard to the claimed *order change elements*. See page 20. Therefore, as the Examiner has neither cited a reference that teaches the claimed *order change elements* nor properly taken official notice that the claimed *order change elements* are well known, Appellants maintain that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 1 and 11. Accordingly, the rejections of claims 1 and 11 should be withdrawn.

ii. **Claims 32 and 33**

Claim 32, which depends directly from claim 1, recites “generating a notice *regarding the change* in the legal criteria.” (*Emphasis added*). In the Examiner’s Answer, the Examiner asserted that:

Appellants claim “generating a notice regarding the change in the legal in the legal criteria.” Exall discloses a system in which content “...is provided and maintained by a third party information source.” (Column 9, lines 16-17) which can be a “...employment law information source...” (Column 9, lines 27-28) (“sources” is associated with “servers” in Column 9, line 25-28). This content can be “...updated on a periodic basis, as required by changes in law...” (Column 9, line 19). The system then may “... retrieve content from employment law information servers...and in turn passing the content directly to the user...” When a user directly receives updated content, the *receipt of that content would serve as a notice to the user* that content has been updated.

Page 20 (*emphasis in original*).

Despite these assertions, however, Appellants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness with respect to dependent claim 32. In particular, the Examiner’s assertion that “When a user directly receives updated content, the *receipt of that content would serve as a notice to the user* that content has been updated” does not satisfy the element of claim 32 that “a notice *regarding the change* in the legal criteria” be generated. Further, the “notice” recited in claim 32 is not “that content has been updated” as asserted above by the Examiner. Rather, the “notice” required by claim 32 is “*regarding the*

change in the legal criteria” that is recited in independent claim 1. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness with respect to claim 32.

Claim 33, which depends from claim 32, recites “wherein the notice *advises the client of the change* in the legal criteria and instructs the client of the *steps that should be taken to remain compliant with the change* in the legal criteria.” (*Emphasis added*). In the Examiner’s Answer, the Examiner asserted that:

Appellants claim “*the notice advises the client of the change in legal criteria and instructs the client of the steps that should be taken to remain compliant with the change in the legal criteria.*” As seen in the explanation of Claim 32 above, the *notice received by the user consists of the actual updated employment law information content*. This content would contain ***the legal information and guidelines*** that are part of the law(s) and therefore would act as ***advisories and instructions on how to remain compliant*** with the laws. By following the legal information that they have in their possession, the user(s) will remain compliant.

Page 21 (*emphasis in original*).

Despite these assertions, however, Appellants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness with respect to dependent claim 33. In particular, the Examiner’s assertions that “As seen in the explanation of Claim 32 above, the *notice received by the user consists of the actual updated employment law information content*. This content would contain ***the legal information and guidelines*** that are part of the law(s) and therefore would act as ***advisories and instructions on how to remain compliant*** with the laws” are not supported by the portions of *Exall* cited by the Examiner in support of his rejection of claim 32.

For example, the Examiner cites to Column 9, lines 16-17, 19, and 25-28 of *Exall* in support of his rejection of claim 32. *Examiner’s Answer*, page 20. However, nothing in these cited portions of *Exall* discusses the “content [containing] ***the legal information and guidelines*** that are part of the law(s)” nor “***instructions on how to remain compliant*** with the laws” as alleged by the Examiner. Therefore, the cited portions of *Exall* do not teach a “notice [that] *advises the*

client of the change in the legal criteria and instructs the client of the *steps that should be taken to remain compliant with the change in the legal criteria*” as required by claim 33. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness with respect to claim 33.

iii. Conclusion

For at least the foregoing reasons, Appellants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 1, 11, 32, and 33. Accordingly, the rejections under 35 U.S.C. § 103(a) of claims 1, 11, 32, and 33, and of claims 2-10, and 29-30 which depend from claim 1, are not well taken and should be overruled by the Board.

- C. **Issue 3: Whether claims 15-18 are unpatentable, under 35 U.S.C. §103(a), as being obvious over *Exall* in view of *PC*, and further in view of U.S. Patent Number 6,067,522 to Warady et al. (“*Warady*”).**

In the Examiner’s Answer, the Examiner again asserted that he never conceded that the “order change elements” are not taught by the cited references. *Examiner’s Answer, page 21*. The Examiner is again mistaken in this assertion for at least the same reasons noted above at III.B.i.

i. The Examiner has failed to demonstrate that the facts of the cited legal precedent are similar to those in the present application

The Examiner is again mistaken in his assertions regarding whether *PC* teaches the *order update element* of claim 15 and the applicability of *KSR* for similar reasons as those noted above at III.B.i.

- ii. **The Examiner has improperly taken official notice in a final office action where the purported facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known**

To the extent that the Examiner has assumed certain disclosures as made or implied in the references, Appellants maintain that the Examiner has, in effect, taken official notice as to such disclosures. In the Examiner's Answer, the Examiner has denied taking official notice with regard to the claimed *order update element*. See page 22. Therefore, as the Examiner has neither cited a reference that teaches the claimed *order update element* nor properly taken official notice that the claimed *order update element* is well known, Appellants maintain that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claim 15. Accordingly, the rejections of claim 15 should be withdrawn.

iii. Conclusion

For at least the foregoing reasons, Appellants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claim 15. Accordingly, the rejections under 35 U.S.C. § 103(a) of claim 15, and of claims 16-18 which depend therefrom, are not well taken and should be overruled by the Board.

- D. **Issue 4: Whether claim 34 is unpatentable, under 35 U.S.C. §103(a), as being obvious over *Exall* in view of *PC*, and further in view of U.S. Patent Publication No. 2002/0055862 to Jinks (“*Jinks*”).**

Appellants note that rejection of claim 34, which depends from claim 1, is problematic for at least the same reasons set forth in the discussion of claim 1 at III.B.i above.

CONCLUSION

Based on the foregoing, Appellants respectfully submit that the rejections of the claims are not well taken. Accordingly, Appellants respectfully request that the Board reverse the Examiner's rejections of claims 1-11, 15-18, 29-30, 32-34 pending in this application and thereby place this application in condition for immediate allowance.

DATED this the 26th day of March, 2010.

Respectfully submitted,

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